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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/619,323	07/14/2003	Lisa K. Jennings	20609/241 (PD) 02036/02037	8249
Edwin V. Merkel NIXON PEABODY LLP Clinton Square P.O. Box 31051 Rochester, NY 14603				
7590 07/30/2008				
EXAMINER				
HADDAD, MAHER M				
ART UNIT		PAPER NUMBER		
1644				
MAIL DATE		DELIVERY MODE		
07/30/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/619,323

**Applicant(s)**

JENNINGS ET AL.

**Examiner**

Maher M. Haddad

**Art Unit**

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 6/30/08 and 01 July 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 72-74 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 72-74 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/CDC)  
4) ☐ Interview Summary (PTO-413)  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_  
Paper No(s)/Mail Date \_\_\_\_\_

RESPONSE TO APPLICANT'S AMENDMENT

1. Applicant's amendment, filed 6/30/08 and 7/1/08, is acknowledged.
2. Claims 72-74 are pending and under examination.
3. In view of the amendment filed on 6/30/08 and 7/1/08, only the following rejection are remained.
4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

*(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.*

*(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.*

5. Claims 72-74 are rejected under 35 U.S.C. 102(a) as being anticipated by Longhurst et al JBC J Biol Chem, Pages 1-40 Epub 2002 Jun 14 for reasons of records.

Applicant's arguments, filed 6/30/08, have been fully considered, but have not been found convincing.

The Declaration of Dr. Lisa K. Jennings under 37 C.F.R 1.132 in accordance with *In Re Katz*, filed 7/1/08, is insufficient to establishing that the Longhurst et al is describing applicants' own work and to overcome the rejection based on 35 U.S.C. § 102 (a) because the Declaration does not indicate the role of George A. Cook in the instant application. Longhurst et al reference is still qualified as an art by another (i.e., 3 inventors vs. 2 authors).

Regarding claim 74 applicant submits that Longhurst fails to identify the peptide consisting of SEQ ID NO: 3 *per se*. In stead, Longhurst merely indicates that the deletion mutant DC9D173-192, which is a 208 residue polypeptide, includes SEQ ID NO:3.

It is the Examiner's position that Longhurst et al teach the five amino acids PKKDV at the N-terminal portion of the FN-binding region (see page 20, line 8 in particular). Longhurst et al explicitly point to the PKKDV peptide.

6. Claims 72-73 are rejected under 35 U.S.C. 102(b) as being anticipated by Jennings et al (1994) (IDS Ref. #6), as evidenced by the specification on page 52, lines 31-32 for reasons of record.

Applicant's arguments, filed 6/30/08, have been fully considered, but have not been found convincing.

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Applicant submits that Jennings describes making various antibodies raised against CD9 peptides, including "peptide 6," there is no description of "peptide 6" other than its relative location within the larger CD9 molecule (see Jennings at Figure 2). Applicant concluded that a person of skill in the art would be left to speculate as to what the exact amino acid sequence of peptide 6 is. Applicant argues that even if an invention is disclosed in a printed publication, that disclosure will not suffice as prior art sufficient to support a rejection under 35 U.S.C. § 102 or § 103 if it was not enabling. In *re Donohue*, 766 F.2d 531,533,226 USPQ 619, 621 (Fed. Cir. 1985). In this case, a person of skill in the art would not be able to identify the exact amino acid sequence of peptide 6, and hence, the person of skill in the art would not appreciate what peptide 6 of Jennings is. In other words, without additional information the person of skill in the art would not be able to make the peptide consisting of SEQ ID NO: 5. For this reason, Jennings cannot anticipate the presently claimed peptide consisting of SEQ ID NO: 5.

However, the Examiner has provided evidence that the referenced peptide 6 is the claimed SEQ ID NO: 5. Applicant did not dispute the evidence but contends that a person of skill in the art would not be able to identify the exact amino acid sequence of peptide 6. However, the instant specification did. The specification on page 52, lines 31-32 discloses that peptide 6 correspond to CD9 EC2 amino acids 168-192 (i.e., claimed SEQ ID NO 5).

Further, since the office does not have a laboratory to test the reference peptide 6, it is applicant's burden to show that the reference peptide is not SEQ ID NO:5 recited in the claim. See *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Marosi*, 218 USPQ 289, 292-293 (Fed. Cir. 1983); and *In re Fitzgerald et al.*, 205 USPQ 594 (CCPA 1980).

7. No claim is allowed.

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maher Haddad whose telephone number is (571) 272-0845. The examiner can normally be reached Monday through Friday from 7:30 am to 4:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Eileen B. O'Hara can be reached on (571) 272-0878. The fax number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

July 23, 2008

/Maher M. Haddad/  
Primary Examiner,  
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